

REMARKS/ARGUMENTS

Claim Status

Claims 1, 2 and 6-32 are pending. Claims 1 and 2 are currently amended. Claims 3-5 are canceled without prejudice. Claims 6-30 are withdrawn due to a previous Restriction Requirement. Claims 31 and 32 are added. Claim 1 is currently amended and finds support in the specification: page 7, lines 2-8 (microcrystalline wax); page 7, lines 26-27 (15-30% of rubber); page 7, line 30, to page 8, line 13, and the examples (natural rubber or polyisoprene rubber); page 2, lines 3-5, and page 9, lines 1-3 (3ppm or less of solvent). Claim 2 is amended for grammatical purposes only. New claims 31 and 32 positively recite one of the alternatives of natural rubber and polyisoprene and share support with the corresponding limitation of claim 1 as described above. No new matter has been entered.

Rejections

Claims 1-3 and 5 are rejected under 35 U.S.C. §102(b) as anticipated by *Hershberger* (US 2,159,152). Claim 4 is rejected under 35 U.S.C. §102(b) as anticipated by *Hershberger* as evidenced by *C.C. Ho et al.* Applicants respectfully traverse these rejections.

For ease of comparison of the wax composition of the claimed process versus that of *Hershberger*, Applicants provide the following table.

Wax composition produced by Applicants' claimed process consisting essentially of:	Wax composition of <i>Hershberger</i> comprising:
a <u>microcrystalline wax</u>	paraffin [pg. 1, para. bridging cols.]
natural rubber or polyisoprene rubber	gum rubber and/or polymers of isoprene
wherein the wax composition comprises <u>15-30%</u> of rubber	wherein the wax composition comprises <u>less than 10%</u> of rubber [pg. 1, left col., l. 37-43]
and the wax composition obtained comprises <u>no more than 3 ppm</u> of solvent.	and the “solvent in such composition is present ... generally to the extent of <u>25% to 50%</u> ” [pg. 2, right col., l. 24-30]

As can be seen from the table above, *Hershberger* fails to disclose (i) microcrystalline wax as the wax of the composition, (ii) an increased amount of rubber in the composition (i.e., 15-30% versus < 10%), and (iii) reduced residual solvent (i.e., ≤ 3ppm versus 25-50%). As the grounds for an anticipation rejection require that the reference disclose, expressly or inherently, each and every element as set forth in the claims (see M.P.E.P. 2131), *Hershberger* does not anticipate the claimed invention. Accordingly, Applicants request withdrawal of the anticipation rejections.

Furthermore, Applicants submit that *Hershberger* does not render obvious the claimed invention. As one instance of non-obviousness in view of *Hershberger*, Applicants point out that *Hershberger* lacks the motivation to increase the rubber content of the wax composition to more than 10%. More specifically, *Hershberger* not only discloses the desire to limit the rubber to “less than 10%” but also discloses that “approximately 4%-7%” is preferably desired when pure rubber is used (see pg.1, left col., l. 37-43).

With this in mind, one skilled in the art would have no motivation to look above either of the thresholds of rubber content; namely 7% or 10%. Furthermore, courts have held that where, as here, the prior art disclosure suggests the outer limits of the range of suitable values, and that the optimum resides within that range, and where there are indications elsewhere that in fact the optimum should be sought within that range, the determination of optimum values outside that range may not be obvious (*In re Sebek*, 465 F.2d 902, 175 USPQ 93, 95 (CCPA 1972)). Thus, without any motivation to consider rubber contents above 7% or at most 10%, Applicants’ claims of 15-30% are not rendered obvious in view of *Hershberger*.

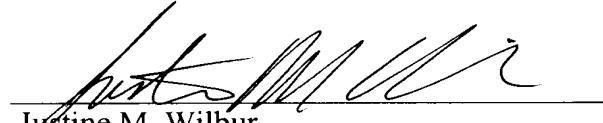
Application No. 10/532,506
Reply to Office Action of November 26, 2008

Conclusion

For the reasons discussed above, Applicants submit that all now-pending claims are in condition for allowance. Applicants respectfully request the withdrawal of the rejections and passage of this case to issue.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon


Justine M. Wilbur
Attorney of Record
Registration No. 59,678

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/07)